

ESTTA Tracking number: **ESTTA723732**

Filing date: **01/29/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	UBISOFT INC
Granted to Date of previous extension	01/31/2016
Address	625 THIRD STREET SAN FRANCISCO, CA 94107 UNITED STATES

Attorney information	Joel D. Leviton Stinson Leonard Street LLP 150 South Fifth Street, Suite 2300 Minneapolis, MN 55402 UNITED STATES joel.leviton@stinson.com,laila.wolfgram@stinson.com,Trademark.MPL@stinson.com Phone:612-335-1562
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Applicant Information

Application No	86568852	Publication date	08/04/2015
Opposition Filing Date	01/29/2016	Opposition Period Ends	01/31/2016
Applicant	Electronic Arts Inc. Legal Department Redwood City, CA 94065 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. First Use: 2013/11/19 First Use In Commerce: 2013/11/19 All goods and services in the class are opposed, namely: Entertainment services, namely, providing an on-line computer game; Provision of information relating to electronic computer games provided via the Internet

Applicant Information

Application No	86568854	Publication date	08/04/2015
Opposition Filing Date	01/29/2016	Opposition Period Ends	
Applicant	Electronic Arts Inc. Legal Department Redwood City, CA 94065 UNITED STATES		

Goods/Services Affected by Opposition

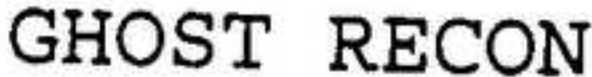
Class 009. First Use: 2013/11/19 First Use In Commerce: 2013/11/19
 All goods and services in the class are opposed, namely: Computer game software; Downloadable computer game software via a global computer network and wireless devices; Video game software

Grounds for Opposition

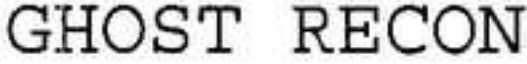
Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2914184	Application Date	03/20/2003
Registration Date	12/28/2004	Foreign Priority Date	NONE
Word Mark	GHOST RECON		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2001/11/13 First Use In Commerce: 2001/11/13 entertainment services namely providingan on-line computer game for others over global and local area computer networks and providing information on-line relating to computer games, video games and computer and video games re- lated products		

U.S. Registration No.	2859669	Application Date	05/23/2003
Registration Date	07/06/2004	Foreign Priority Date	NONE
Word Mark	GHOST RECON		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2001/11/13 First Use In Commerce: 2001/11/13 software and electronic games, namely, software games recorded on CD-ROM and digital video discs for computers; software games recorded on CD-ROMs, digital video discs, and cartridges for console andindividual, portable gaming systems; software games that are downloadable from a remote computer site; and software games for mobile phones, [personal digitalassistants,] and hand-held computers		

U.S. Registration No.	3147364	Application Date	10/18/2005
Registration Date	09/26/2006	Foreign Priority Date	NONE
Word Mark	GHOST RECON		


Design Mark	
Description of Mark	NONE
Goods/Services	Class 016. First use: First Use: 2001/11/30 First Use In Commerce: 2001/11/30 computer game instruction manuals and published guides containing suggestions on how to play the computer games


U.S. Registration No.	3117792	Application Date	05/16/2005
Registration Date	07/18/2006	Foreign Priority Date	NONE
Word Mark	GHOST RECON ADVANCED WARFIGHTER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2006/03/30 First Use In Commerce: 2006/03/30 software and electronic games, namely, software games recorded on CD-ROM and digital video discs for computers; software games recorded on CD-ROMs, digital video discs, [and cartridges for console and individual, portable gaming systems;] software games that are downloadable from a remote computer site; and software games for mobile phones, [personal digital assistants, and handheld computers]		


U.S. Registration No.	4218392	Application Date	08/05/2010
Registration Date	10/02/2012	Foreign Priority Date	NONE
Word Mark	GHOST RECON		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2012/05/21 First Use In Commerce: 2012/05/21 Entertainment services, namely, providing online games, non-downloadable		

	computer games and video games, and providing information, news, and commentary in the field of computer games and video games; entertainment services, namely, providing a website featuring tips, hints, contests, computer interface themes and enhancements, audio-visual content, music, films, videos, animated series, and other multimedia materials, all in the field of computer games and video games
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U.S. Registration No.	4811226	Application Date	08/26/2014
Registration Date	09/15/2015	Foreign Priority Date	NONE
Word Mark	GHOST RECON		
Design Mark			
Description of Mark	The mark consists of the literal element "GHOST RECON" with "GHOST" appearing above "RECON". The "O" of "RECON" has been replaced by a skull in a circle.		
Goods/Services	Class 009. First use: First Use: 2006/03/30 First Use In Commerce: 2006/03/30 Game software and electronic game programs, namely, software games recorded on CD-ROM and digital video discs for computers; software games recorded on CD-ROMs, digital video discs, and cartridges for console and individual portable gaming systems		

U.S. Registration No.	3924055	Application Date	12/14/2009
Registration Date	02/22/2011	Foreign Priority Date	NONE
Word Mark	GHOST RECON FUTURE SOLDIER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2010/03/31 First Use In Commerce: 2010/03/31 Entertainment services, namely, providing an on-line computer game for others over global and local area computer networks and providing information on-line relating to computer games, video games and computer and video games related products		

U.S. Registration No.	4179487	Application Date	01/18/2012
Registration Date	07/24/2012	Foreign Priority Date	NONE
Word Mark	GHOST RECON		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 2008/11/15 First Use In Commerce: 2008/11/15 printed matter, namely, books featuring works of fiction		

U.S. Registration No.	4202718	Application Date	12/14/2009
Registration Date	09/04/2012	Foreign Priority Date	NONE
Word Mark	GHOST RECON FUTURE SOLDIER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2012/05/31 First Use In Commerce: 2012/05/31 Game software and electronic game programs, namely, software games recorded on CD-ROM and digital video discs for computers; software games recorded on CD-ROMs, digital video discs, and cartridges for console and individual, portable gaming systems; software games that are downloadable from a remote computer site and electronic game software for mobile phones, personal digital assistants, and handheld computers		

U.S. Registration No.	4625623	Application Date	03/07/2013
Registration Date	10/21/2014	Foreign Priority Date	NONE
Word Mark	GHOST RECON		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 2013/03/31 First Use In Commerce: 2013/03/31 Clothing, namely, headwear; shirts; tops; hats; caps

Attachments	76517476#TMSN.png(bytes) 76648721#TMSN.png(bytes) 76638844#TMSN.png(bytes) 85101015#TMSN.png(bytes) 86376729#TMSN.png(bytes) 77892377#TMSN.png(bytes) 85518911#TMSN.png(bytes) 77892381#TMSN.png(bytes) 85869434#TMSN.png(bytes) Notice of Opposition against GHOST - final pdf.PDF(105842 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/laila s. wolfgram/
Name	Laila S. Wolfgram
Date	01/29/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

UBISOFT ENTERTAINMENT AND
UBISOFT, INC.,

Opposers,

v.

ELECTRONIC ARTS INC.,

Applicant.

Opposition No.: _____

Mark: GHOST

Serial Nos. 86/568,852
86/568,854

Published: August 4, 2015

NOTICE OF OPPOSITION

Ubisoft Entertainment, a French corporation having a principal place of business at 107 Avenue Henri Freville, Rennes, France, and Ubisoft, Inc. (“Ubisoft”), a California corporation having a principal place of business at 625 Third Street, San Francisco, California 94107, believe they will be damaged by registration of the mark shown in Application Serial Nos. 86/568,852 and 86/568,854 (the “Applications”) and hereby oppose the same pursuant to the provisions of 15 U.S.C. § 1063. Ubisoft Entertainment and Ubisoft are collectively referred to as “Opposers.”


The grounds for opposition are as follows:

1. Opposer Ubisoft Entertainment is the parent company of Ubisoft. Therefore, privity exists between Opposers. Both Ubisoft Entertainment and Ubisoft are video game developers and publishers and also sell various products and services related to their video games and entertainment services.

2. Since at least as early as 2001, Ubisoft has used the trademark GHOST RECON in connection with video games and entertainment services in the nature of online video and computer games. In addition to its longstanding common law trademark rights, Ubisoft owns several incontestable federal registrations for marks comprising or containing the distinctive GHOST RECON trademark, including the following trademarks:

Trademark	Registration No.	Date Registered	Goods/Services
GHOST RECON	Incontestable Reg. No. 2,914,184	December 28, 2004	Entertainment services namely providing an on-line computer game for others over global and local area computer networks and providing information on-line relating to computer games, video games and computer and video games related products in Int. Class 41
GHOST RECON	Incontestable Reg. No. 2,859,669	July 6, 2004	Software and electronic games, namely, software games recorded on CD-ROM and digital video discs for computers; software games recorded on CD-ROMs, digital video discs, and cartridges for console and individual, portable gaming systems; software games that are downloadable from a remote computer site; and software games for mobile phones, and handheld computers.in Int. Class 9
GHOST RECON	Incontestable Reg. No. 3,147,364	September 26, 2006	Computer game instruction manuals and published guides containing suggestions on how to play the computer games in Int. Class 16
GHOST RECON ADVANCED WARFIGHTER	Incontestable Reg. No. 3,117,792	July 18, 2006	Software and electronic games, namely, software games recorded on CD-ROM and digital video discs for computers; software games recorded on CD-ROMs, digital video discs, software games that are downloadable from a remote computer site; and software games for mobile phones in Int. Class 9

3. Ubisoft Entertainment also owns several federal registrations for marks comprising or containing the distinctive GHOST RECON trademark, including the following trademarks:

Trademark	Registration No.	Date Registered	Goods/Services
GHOST RECON	Reg. No. 4,218,392	October 2, 2012	Entertainment services, namely, providing online games, non-downloadable computer games and video games, and providing information, news, and commentary in the field of computer games and video games; entertainment services, namely, providing a website featuring tips, hints, contests, computer interface themes and enhancements, audio-visual content, music, films, videos, animated series, and other multimedia materials, all in the field of computer games and video games in Int. Class 41
	Reg. No. 4,811,226	September 15, 2015	Game software and electronic game programs, namely, software games recorded on CD-ROM and digital video discs for computers; software games recorded on CD-ROMs, digital video discs, and cartridges for console and individual portable gaming systems in Int. Class 9
GHOST RECON FUTURE SOLDIER	Reg. No. 3,924,055	February 22, 2011	Entertainment services, namely, providing an on-line computer game for others over global and local area computer networks and providing information on-line relating to computer games, video games and computer and video games related products in Int. Class 41
GHOST RECON FUTURE SOLDIER	Reg. No. 4,202,718	September 4, 2012	Game software and electronic game programs, namely, software games recorded on CD-ROM and digital video discs for computers; software games recorded on CD-ROMs, digital video discs, and cartridges for console and individual, portable gaming systems; software games that are downloadable from a remote computer site and electronic game software for mobile phones, personal digital assistants, and handheld computers in Int. Class 9
GHOST RECON	Reg. No. 4,179,487	July 24, 2012	Printed matter, namely, books featuring

			works of fiction in Int. Class 16
GHOST RECON	Reg. No. 4,625,623	October 21, 2014	Clothing, namely, headwear; shirts; tops; hats; caps in Int. Class 25

Collectively, the marks that set forth in Paragraphs 2 and 3 are referred to as the GHOST RECON marks.

4. Notwithstanding Ubisoft Entertainment's and Ubisoft's prior rights in the GHOST RECON mark, on March 18, 2015, applicant Electronic Arts Inc. ("Applicant") filed two intent-to-use applications seeking to register the mark GHOST ("Applicant's Mark"): one was filed in connection with "Computer game software; Downloadable computer game software via a global computer network and wireless devices; Video game software" in International Class 9, which was designated 86/568,854, and the other one was filed in connection with "Entertainment services, namely, providing an on-line computer game; Provision of information relating to electronic computer games provided via the Internet" in International Class 41, which was designated 86/568,852.

5. The Applications were published for opposition on August 4, 2015. Ubisoft sought, and was granted, two extensions of time to oppose the Applications: one on September 2, 2015 and one on November 30, 2015. As a result, Opposers have until January 31, 2016 to oppose the Application. Therefore, this Notice of Opposition is timely filed.

6. Opposers began using its GHOST RECON marks in connection with video games and entertainment services long before Applicant filed the Applications on March 18, 2015 and long before Applicant's November 19, 2013 claimed date of first use.

7. Opposers' common law and statutory priority dates precede the filing date of the Application and, upon information and belief, any priority date upon which Applicant may rely.

8. Opposers have priority over Applicant.

9. Prior to filing the Applications, Applicant had constructive knowledge of Opposers' GHOST RECON marks given Opposers' federal registrations set forth above.

10. The goods and services identified in the Applications, namely "Computer game software; Downloadable computer game software via a global computer network and wireless devices; Video game software" and "Entertainment services, namely, providing an on-line computer game; Provision of information relating to electronic computer games provided via the Internet" are identical and highly related to the goods and services offered by Opposers in connection with the GHOST RECON marks.

11. Upon information and belief, Applicant intends to market the goods and services identified in the Applications to the same consumers who purchase the goods and services offered by the Opposers under the GHOST RECON marks.

12. Applicant's proposed mark GHOST mark is nearly identical to the GHOST RECON marks used and owned by Opposers.

13. Applicant's Mark so resembles Opposers' GHOST RECON marks alleged herein as to be likely, when used in connection with the goods and services identified in the Applications, to cause confusion, to cause mistake, or to deceive. Consumers are likely to believe, mistakenly, that the goods and services Applicant offers under Applicant's Mark are provided, sponsored, endorsed, or approved by Opposers, or are in some way affiliated, connected, or associated with Opposers, all to the detriment of Opposers. Registration of Applicant's Mark, therefore, should be refused under 15 U.S.C. §§ 1052(d) and 1063.

14. Registration of Applicant's Mark would be a further source of damage to Opposers, as it would confer upon Applicant various statutory presumptions to which it is not entitled in view of Opposers' long prior use of the GHOST RECON marks.

WHEREFORE, pursuant to Section 13 of the Lanham Act, 15 U.S.C. § 1063, Opposers respectfully request that their opposition be sustained and that registration of the mark shown in Application Serial Nos. 86/568,852 and 86/568,854 be refused.

Please charge the Notice of Opposition fee to the Deposit Account of Stinson Leonard Street LLP Account No. 19-4409.

Respectfully submitted,

Date: January 29, 2016

/Joel D. Leviton/

Joel D. Leviton
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Telephone: (612) 335-1562
Facsimile: (612) 335-1657

Attorneys for Ubisoft, Inc. and
Ubisoft Entertainment

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the NOTICE OF OPPOSITION has been served this 29th day of January, by First Class U.S. Mail, postage prepaid, upon Applicant at the following addresses:

VINEETA GAJWANI
Electronic Arts Inc
209 Redwood Shores Pkwy
Redwood City, CA 94065-1175

/Joel D. Leviton/

Joel D. Leviton